

Serial No.: 09/657,357

- 2 -

Art Unit: 2644

As discussed in Applicant's previous response, filed December 23, 2005, Whitby is directed to a radio receiver for receiving broadcast programming. The radio receiver includes a random access memory for recording the program signal, in digital form, and a controller that allows a user to play back the program signal stored in the memory.

Thomason is directed a memory device for storing an information signal. Thomason states that the memory device can be used in a television or video recorder. According to Thomason, the memory device has an input buffer and an output buffer such that an information signal can be stored in memory and an information signal previously stored in memory can be simultaneously retrieved from the memory. Thomason states that, using this arrangement, provided the right channel is being monitored, a viewer does not have to wait until a program has finished before watching the recorded version of program. Thomason also states that if the viewer is not watching live, he can catch up to a live broadcast by accelerating the playback.

Applicant's independent claim 1, as amended, recites a "repeat circuit for use with an audio receive and reproduce device that has a normal mode and a replay mode... wherein said device is configured to automatically control the rate at which said RAM is read out to said replay audio input of said device, said RAM being read out to said replay audio input of said device at a replay rate that is different than an incoming rate at which the incoming audio inputs are received to be stored in said RAM; wherein said replay rate is selected so as to gradually eliminate the delay time without substantially impairing audio quality of the replayed audio, thereby automatically returning said device to normal mode. Such a repeat circuit is not disclosed or suggested by the prior art of record.

In the Office Action, the Examiner acknowledges that Whitby fails to disclose "wherein said device is automatically configured to control the rate at which said RAM is read out to said replay audio input of said device, said RAM being read out... at a replay rate that is different than an incoming rate... or wherein said replay rate is selected so as to gradually eliminate the delay time without substantially impairing audio quality of the replayed audio, thereby automatically returning said device to normal mode." However, the Examiner looks to Thomason to supply the missing subject matter, stating that Thomason discloses a means of accelerating the viewing of a historical program and that an acceleration

792787.1

Serial No.: 09/657,357

- 3 -

Art Unit: 2644

factor of a few percent is practically unnoticeable. The Examiner asserts that "it would have been obvious...to apply the teachings of Thomason to the device disclosed by Whitby" and that "one would have been motivated to do so in order to start a program on the Whitby device well after it started, to maintain continuity after interruption, have the ability to replay or playback in slow motion." Applicant respectfully disagrees with these assertions.

First, contrary to the assertions in the Office Action, there is no proper motivation present in the references to lead one of ordinary skill in the art to make the proposed combination. The motivation to make this combination of references comes from Applicant's disclosure and is thus based on improper hindsight. There is no motivation to combine the references as asserted in the Office Action.

As noted above, Thomason is directed to a device that is clearly identified as being for use in a television or video recorder. Despite the fact that radios were well known at the time of filing of Thomason, Thomason never mentions or suggests in any way that the memory device could be used in a radio. Whereas automatic recorders have been widely used in connection with televisions, such technology traditionally has not been applied to radios. The law is clear that to sustain a rejection under 35 U.S.C. § 103, there must be a clear teaching, suggestion or motivation present in the prior art of record that would lead of ordinary skill in the art to make the combination and/or modification. In this case, such teaching, suggestion or motivation is wholly lacking in the prior art. The only suggestion to provide a radio device with an automatic recorder that "is configured to automatically control the rate at which said RAM is read out to said replay audio input of said device" and "wherein said replay rate is selected so as to gradually eliminate the delay time without substantially impairing audio quality of the replayed audio," is found in Applicant's own specification. It is only in hindsight, based on Applicant's own specification and claims, that one might think to apply Thomason's disclosure to the device disclosed by Whitby. However, such hindsight-based reasoning is impermissible. The required suggestion or motivation to combine and/or modify references must be clear and recognizable in the prior art itself, without reference to Applicant's specification or claims, and in this case it is not. Accordingly, because there is nothing in the references of record that would lead one of ordinary skill in the art to combine

792787.1

Serial No.: 09/657,357

- 4 -

Art Unit: 2644

Whitby and Thomason, the combination is improper. Therefore, the rejection should be withdrawn.

Furthermore, even if one were to combine Whitby and Thomason as proposed in the Office Action, the combination fails to disclose or suggest at least one limitation recited in Applicant's claim 1. Claim 1 recites "wherein said replay rate is selected so as to gradually eliminate the delay time...thereby automatically returning said device to normal mode" (emphasis added). This feature is not disclosed or suggested by Whitby and/or Thomason, whether considered alone or in combination. "Normal mode" is defined in Applicant's specification to mean a mode in which incoming audio inputs are applied directly to the audio inputs of the radio. In other words, a mode in which the user is listening to a real-time incoming signal. By contrast, "replay mode" is defined as a mode in which the audio input to the radio is received from the RAM. In other words, the incoming audio has been stored in RAM and is now being played out, while the current incoming audio is inhibited from the radio (either discarded or stored in the RAM to be played out after a time delay). According to Applicant's claim 1, when the delay time is eliminated, the device is automatically returned from replay mode to normal mode. This is not disclosed by either Whitby or Thomason.

Thomason discloses that a viewer watching a historical program (i.e., watching a program being supplied from the memory) can "catch up" with the live broadcast by accelerating the playback. However, nowhere does Thomason disclose or suggest that once that viewer has "caught up," the device is automatically returned to a mode in which the program is no longer supplied via the memory. Rather, Thomason suggest that either the viewer will continue to watch the program supplied through the recorder, but with no substantial delay, or that the viewer will have to manually turn off the recorder. There is absolutely no indication whatsoever in Thomason that after the delay time is eliminated, the device (in Thomason's case, the television) is automatically returned to normal mode, as is recited in Applicant's claim 1. This feature is also not shown or suggested by Whitby. Therefore, even in combination, Whitby and Thomason fail to disclose or suggest at least one limitation recited in Applicant's claim 1.

In view of the foregoing, withdrawal of the rejection of claim 1 is respectfully requested. Claims 2-4, 8-18 and 36 depend from claim 1 and are therefore allowable for at

792787.1

Serial No.: 09/657,357

- 5 -

Art Unit: 2644

least the same reasons as is claim 1. Accordingly, withdrawal of the rejection of claims 2-4, 8-14 and 36 is respectfully requested.

Applicant's independent claims 23 and 40 each recite the stored audio is played out a rate which is controlled so as to "gradually eliminate the time period" without substantially impairing the audio quality. The Examiner acknowledges that this feature is not disclosed by Whitby, but looks to Thomason to cure the deficiency of Whitby. As discussed above, the proposed combination of Whitby and Thomason is improper for lack of motivation to combine. There is no indication in the prior art that features of Thomason's video recorder could be applied to Whitby's radio. Rather, any suggestion to combine Thomason and Whitby comes from hindsight based on Applicant's own specification and claims; which is impermissible. Accordingly, because the proposed combination of Whitby and Thomason is improper, the rejection fails. Therefore, withdrawal of the rejection of claims 23 and 40 is respectfully requested.

Applicant's independent claim 28 recites a "repeat circuit for use with a radio having a normal mode and a replay mode...wherein said radio is automatically returned from replay mode to normal mode with incoming audio inputs applied to said radio when there is a station change on the radio" (emphasis added). The Examiner acknowledges that this limitation is not disclosed by Whitby and/or Thomason, but states that "it is extremely obvious if not implicit that as the user change the station the system will begin recording as normal." This reasoning is flawed and appears to reflect a misunderstanding regarding "normal mode" and "replay mode" as defined in Applicant's specification.

As discussed above, in "normal mode," incoming audio inputs are applied directly to the audio inputs of the radio. By contrast, in "replay mode," the audio input to the radio is received from the RAM and incoming audio is inhibited from the radio, but can stored in the RAM to be played out after a time delay. Thus, when the device is in replay mode, it is "recording as normal." "Normal mode" does not equate with "recording as normal" as appears to be suggested by the Examiner. Rather, normal mode and replay mode refer to the source of the audio input to the radio, whether or not the device is recording.

Whitby similarly discloses that when the device is in playback mode, it continues to record. For example, see page 10, line 12 to page 11, line 18. In fact, were the device not

792787.1

Serial No.: 09/657,357

- 6 -

Art Unit: 2644

recording when in playback mode, when the user has finished listening to the recorded portion there would be a break or period of lost data equal to the length of the playback. The notion that the device does not record when in playback mode is contrary to Whitby's disclosure on page 11, lines 7-18. Thus, because Whitby's device is "recording as normal" when in playback mode, it would be perfectly logical to have the device remain in playback mode when the station is changed on the radio.

Whitby neither discloses automatic switching between replay and normal modes when the radio station is changed, nor is this feature inherent or "implicit" in Whitby. There is nothing in Whitby that discloses or suggests that if the device is a replay mode (i.e., is storing and delayedly playing out audio) that changing the radio station will cause the device to change into a different mode. The law is clear that the prior art must contain a definite teaching, suggestion or motivation that would lead one of ordinary skill in the art to either combine to references or modify a reference (or combination of references). This required teaching, suggestion or motivation is completely lacking in the instant case. Although Whitby discloses that a user can tune the radio to change the station (page 5, lines 14-15 referenced by the Examiner), Whitby does not link the station change to a change in the mode of the device. Furthermore, this feature is not shown in Thomason or any other reference of record, whether taken alone or in combination with Whitby. In addition, as discussed above, causing the device to change mode when there is a station change is neither "obvious" nor "implicit," as stated by the Examiner because Whitby's device is "recording as normal" when in playback mode. Thus, there is absolutely no suggestion or motivation present in the prior art of record to modify Whitby (whether considered alone or in combination with Thomason) such that the "radio is automatically returned from replay mode to normal mode with incoming audio inputs applied to said radio when there is a station change on the radio," as is claimed in Applicant's claim 28. Therefore, for at least these reasons, Applicant's claim 28 is patentable over the art of record and withdrawal of the rejection of claim 28 is respectfully requested.

Claims 29, 30 and 37-39 depend from claim 28 and are therefore allowable for at least the same reasons as discussed for claim 28. Accordingly, withdrawal of the rejection of claims 28, 30 and 37-39 is respectfully requested.

792787.1

RECEIVED
CENTRAL FAX CENTER
SEP 05 2006

Serial No.: 09/657,357

- 7 -

Art Unit: 2644

Claims 6 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Whitby and Thomason in further view of Oftedahl (U.S. Patent No. 6,449,768). Applicant respectfully traverses this rejection.

As discussed above, the proposed combination of Whitby and Thomason is improper for lack of motivation to combine. Since Oftedahl also contains no teaching, suggestion or motivation that would lead one of ordinary skill in the art to combine Whitby and Thomason, Oftedahl cannot be combined with this already improper combination of Whitby and Thomason. In addition, Whitby and Thomason, whether taken alone or in combination, fail to disclose or suggest at least one limitation recited in Applicant's independent claim 1, from which claims 6 and 7 depend. Oftedahl fails to cure the deficiencies of Whitby and Thomason because Oftedahl also does not disclose or suggest "wherein said replay rate is selected so as to gradually eliminate the delay time without substantially impairing audio quality of the replayed audio, thereby automatically returning said device to normal mode." Accordingly, even if one were to make the combination of Whitby, Thomason and Oftedahl as proposed in the Office Action, the combination fails to disclose or suggest at least one limitation recited in Applicant's claims and therefore fails to render Applicant's claims unpatentable. Accordingly, withdrawal of the rejection of claims 6 and 7 is respectfully requested.

CONCLUSION

In view of the foregoing amendments and remarks, reconsideration is respectfully requested. This application should now be in condition for allowance; a notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.

792787.1


Serial No.: 09/657,357

- 8 -

Art Unit: 2644

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, please charge any such fee to Deposit Account No. 50/2762.

Respectfully submitted,
Kenneth P. Weiss, Applicant

By: 
John N. Anastasi, Reg. No. 37,765
Sarah M. Gates, Reg. No. L0045.
LOWRIE, LANDO & ANASTASI, LLP
One Main Street
Cambridge, Massachusetts 02142
United States of America
Telephone: 617-395-7000
Facsimile: 617-395-7070

Docket No.: W0537-7005
Date: September 5, 2005

792787.1